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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/700,078

11/03/2003

Brian Michael Bridgewater

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EXAMINER

NERANGIS, VICKEY MARIE

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

04/30/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/700,078	<b>Applicant(s)</b> BRIDGEWATER ET AL.	
	<b>Examiner</b> VICKEY NERANGIS	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) 10-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 15-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 1796

**DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
2. No new grounds of rejection are set forth below. Thus, the following action is properly made final.

***Claim Rejections - 35 USC § 112***

3. Claims 16 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The rejection was adequately set forth in paragraph 3 of Office action mailed on 12/3/2008 and is incorporated here by reference.

***Claim Rejections - 35 USC § 102/103***

4. Claims 2-5, 7, and 17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Friel (US 5,731,377).

The rejection was adequately set forth in paragraph 4 of Office action mailed on 12/3/2008 and is incorporated here by reference.

***Claim Rejections - 35 USC § 103***

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friel (US 5,731,377).

Art Unit: 1796

The rejection was adequately set forth in paragraph 5 of Office action mailed on 12/3/2008 and is incorporated here by reference.

6. Claims 1, 3-7, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friel (US 5,731,377) in view of Ishikawa (US 4,325,856).

The rejection was adequately set forth in paragraph 6 of Office action mailed on 12/3/2008 and is incorporated here by reference.

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friel (US 5,731,377) in view of Ishikawa (US 4,325,856) and further in view of Bricker (US 5,502,089).

The rejection was adequately set forth in paragraph 7 of Office action mailed on 12/3/2008 and is incorporated here by reference.

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friel (US 5,731,377) in view of Bricker (US 5,502,089).

The rejection was adequately set forth in paragraph 8 of Office action mailed on 12/3/2008 and is incorporated here by reference.

### ***Response to Arguments***

9. Applicant's arguments filed 3/3/2009 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that the claims 16 and 17 comply with the written restriction requirement and (B) that the process of making the polymer in the present

Art Unit: 1796

product-by-process claims clearly provides for a different product as evidenced by the 37 CFR 1.132 declaration filed on 3/3/2009.

With respect to argument (A), concerning claim 16, the amount of initiator of 0.08 % based on the dry polymer weight during the first 10 wt % of monomer conversion fails to satisfy the written description requirement of 35 USC 112, first paragraph. Example 1 on page 17 of the specification only provides support for an initial amount 0.078 wt % and not for 0.08 wt % during the first 10 wt % of monomer conversion. Concerning claim 17, the amount of initiator of 0.03 % based on the dry polymer weight during the first 10 wt % of monomer conversion fails to satisfy the written description requirement of 35 USC 112, first paragraph. Example 2 on page 18 of the specification only provides support for an initial amount 0.3 wt % during the first 10 wt % of monomer conversion for a polymer prepared with a chain transfer agent (which is absent from claim 17).

With respect to argument (B), the new data in Table 2 of the declaration filed on 3/3/2009 only shows criticality with respect to scrub resistance of paint, however, the inconsistent amounts of rheology modifier in the examples make the examples improper side-by-side examples. Thus, it is impossible to tell whether the scrub resistance properties of the inventive and comparative examples are dependent on the process. As discussed in the Examiner's Answer mailed on 7/10/2006, to clearly establish the insignificance of the type of rheology modifier and that the inventive and comparative data are proper side-by-side examples, such must be clearly supported with factual evidence.

Furthermore, the inventive and comparative data of the declaration and specification have been fully considered and are not found to be reasonably commensurate in scope with the

Art Unit: 1796

claimed invention. The amount of total initiator (for claim 1 only) and the amount of initiator used in the first 10 wt % of monomer conversion is still not reasonably commensurate in scope with the presently claimed process ranges. See the Tables below. Case law holds that whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the “objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support.” In other words, the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range (i.e., scope). *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980), MPEP 716.02(d). Given that the amounts of initiator are important in the presently claimed process and further given that applicant has not shown that improved scrub resistance properties (which are arguably due to multiple elution times in GPC-MALS) are had throughout the presently claimed amount ranges, criticality for the entire scope of the presently claimed process on the final product cannot be supported.

Specifically, concerning claim 1, the data only includes 0.3-0.35 wt % total initiator wherein the claim requires 0.3-0.4 wt % total initiator. Furthermore, the exemplified amounts of initiator added during the first 10 wt % of monomer conversion (0.05, 0.03, and 0.10) are not reasonably commensurate in scope with claimed less than 0.15 wt %. Concerning claim 2, the exemplified amounts of initiator added during the first 10 wt % of monomer conversion (20, 23, 20, 10, 35, and 22.2 wt %) are not reasonably commensurate in scope with claimed less than half (i.e., 50 wt %). It is noted that the emulsion polymer and type and amount of neutralize is reasonably commensurate in scope with the scope of the claims.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Nerangis whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1796

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

4/29/2009

vn

/Vickey Nerangis/  
Examiner, Art Unit 1796